

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

APPLICANT: Peter Fajkowski

SERIAL NO.: 29/297,532

DOCKET NO.: 8958.004

FILED: June 28, 1999

ART UNIT: 2876

EXAMINER: St. Cry, D.

TITLE: Method & Apparatus for Coupon Management & Redemption

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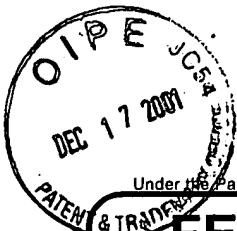
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FEE TRANSMITTAL for FY 2002 <small>Patent fees are subject to annual revision.</small>		Complete if Known	
		Application Number	29/297,532
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Filing Date	June 28, 1999
		First Named Inventor	Fajkowski
TOTAL AMOUNT OF PAYMENT (\$)		Examiner Name	St. Cry, D.
		Group Art Unit	2876
		Attorney Docket No.	8958.004

METHOD OF PAYMENT (check all that apply)		FEE CALCULATION (continued)																																																																																																																																																																																							
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SUBMITTED BY		Complete (if applicable)	
Name (Print/Type)	William David Kiesel	Registration No. (Attorney/Agent)	25,883
Signature		Telephone	225-927-9908
		Date	12/17/01

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12-20-01

AT-12876/1

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

APPLICANT: Peter W. Fajkowski TITLE: Method and Apparatus for Coupon
Management and Redemption

SERIAL NO.: 09/297,532 ART UNIT: 2876

FILING DATE: June 28, 1999 EXAMINER: St. Cyr, D.

DOCKET NO.: 8958.004

Brief in Support of an Appeal

The Honorable Commissioner of
Patents and Trademarks
Box Patent Appeals
P.O. Box 2327
Arlington, VA 22202

Dear Sir:

This brief is filed in support of the applicant's appeal of the examiner's final rejection mailed April 17, 2001. The applicant filed a notice of appeal together with a petition for a three (3) month extension on October 17, 2001. Therefore, this brief was due sixty (60) days after the filing of the notice of appeal and is believed to be timely filed. However, if any additional extension is required, please consider this an extension therefor. A check for \$160 for the fee for filing a brief in support of an appeal is included herewith. No additional fees are believed to be due at this time; however, if any are due the Commissioner is authorized and respectfully requested to charge the same to deposit account no. 18-2210.

The examiner's rejections are respectfully traversed, and the Board is respectfully requested to reverse the examiner's rejections of the applicant's claims for the reasons detailed below.

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15/ Appeal
Brief
G. Stucky
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The Examiner's Objections to the Informalities

The examiner's objections to the claim language is acceded to. The applicant respectfully requests that the examiner enter an examiner's amendment corresponding to the requirements set out on page 1 of the April 17, 2001, office action or that the case be remanded to the examiner to allow the applicant to submit the appropriate amendments, after the Board addresses the merits of the appealed rejections.

Claims 25, 42

Claim 25 is an independent claim. It is set out below:

25. A method for the radio broadcast of electronic coupon data to a specific storage device comprising the steps of:

- a. predetermining what coupon data will be broadcast to a specific storage device; and
- b. broadcasting a signal carrying said coupon data wherein said signal is modified to be receivable by said specific storage device.

Claim 42 is dependent upon claim 25. It is set out below:

42. A method according to claim 25, further comprising the step of receiving and recording said radio broadcast with a storage device having a radio receiver.

The examiner has rejected claims 25 and 42 in view of U.S. Patent 5,424,524 to Ruppert *et al.* ("Ruppert"). To establish his *prima facie* case of obviousness under § 103 the examiner must establish that the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP §§ 706.02 (j); 2143.03. As the examiner has conceded, Ruppert does not teach or suggest the use of radio broadcast for transmitting the coupon data. April 17, 2001. Office Action, Page 3.

In rejecting claims 25 and 42, the examiner contends that the infrared transceiver

disclosed in Ruppert is an “alternate and functional equivalent communication means” to radio transmission. This is hardly the case. Radio transmission is capable of communication across much greater distances than those suitable for infrared transmissions. However, for the present purposes, what is important is that the examiner has not made any showing that radio transmission and infrared transmissions are recognized as equivalents in the prior art. Such a showing is required in order to establish a *prima facie* case of obviousness based on the substitution of one alleged equivalent for another. MPEP § 2144.06.

Rather than make such a showing, the examiner has relied upon the applicant’s disclosure. As a legal matter, this is improper. MPEP § 2144.06. As a factual matter it is simply incorrect. In arguing that the applicant teaches that radio transmission and infrared transmission are equivalent, the examiner cites page 12 of the specification. While that portion of the specification references infrared transceiver devices as potential substitutes for magnetic disk writing or laser transmit-receive devices such as those used with CD ROM devices, radio transmission devices are not mentioned at all. Rather, the specification addresses radio transmission in an entirely different context on page 43. There, the specification discusses the use of radio transmissions as a substitute for the use of telephone lines to communicate with remote database 410. Nowhere in the specification does the applicant suggest that infrared transmissions would be acceptable for this task, and the examiner is in error to the extent that he suggests otherwise.

The examiner also argues that “being functionally equivalent is to perform *similar function*.” (April 17, 2001, Office Action, p. 4, emphasis added). This is simply not correct. The examiner must show that the equivalency is recognized in the prior art. MPEP § 2144.06.

“The mere fact that components are *functional or mechanical equivalents*” is not sufficient to establish equivalency. MPEP § 2144.06 (emphasis added). Thus, even if infrared data transmission was functionally similar to radio data transmission, as the examiner alleges, that would not establish that the two are equivalents for purposes of § 103.

In view of the foregoing, the examiner has clearly not established that sending data via infrared transmission is recognized by the prior art as an equivalent of sending data via radio signals, and accordingly, has not established his *prima facie* case with respect to claims 25 and 42. Therefore, the rejection should be withdrawn and an early notice of allowability is respectfully requested for those claims.

Claims 43-45

Claim 43 is independent. Claims 44 and 45 depend from 43. Claim 43 is set out below.

An adapter for converting recorded data on a disk device to electrical data for wireless transmission of the contents of said recorded data to a storage device, said adapter comprising:

- a. an adapter body sized to be inserted in a disk drive;
- b. an insertion port formed on said body for receiving said storage device;
- c. a memory on said body for receiving the contents of said recorded data;
- e. a wireless transmitter on said body for receiving electrical data and transmitting said electrical data in a wireless signal; and
- f. a processor on said body for converting the contents of said recorded data into electrical data which may be transmitted through said wireless transmitter.

Claims 43 and 44 have been rejected under 35 U.S.C. § 102(e) in view of U.S. Patent 5,663,553 to Aucsmith (“Aucsmith”). Aucsmith discloses a device for transmitting data between a “smart card” and a data processing machine. The preferred embodiment is

essentially a carrier shaped like a 3½" floppy disk. The carrier is sized to receive a smart card. The carrier can read and store the information on the smart card. When the carrier is inserted into the 3½" floppy disk of a personal computer, for example, the carrier transmits the data received from the smart card to the PC. The methods disclosed in Aucsmith for allowing the smart card to communicate with the carrier or the carrier to communicate with the PC or other data processing unit are:

- 1) frictional contact between card contact pads 328 to close an electrical circuit; and
- 2) a magnetic coil connected to a magnetic transducer.

See, Aucsmith Col. 4, ll. 34-46; Col. 4, ln. 62 - Col. 5, ln. 5; Col. 5, ll. 32-42; Col. 6, ll. 31-53.

Both of the means of data transmission disclosed in Aucsmith require either immediate contact between the sending and receiving units or, in the context of the magnetic coil and transducer, a separation that is vanishingly small. Neither of these data transmission means would satisfy the limitation in claim 42 requiring a "*wireless* transmitter for receiving electrical data and transmitting said electrical data in a *wireless* signal," as such a limitation clearly requires the transmitter be able to transmit and receive signals over a distance, as by radio or other EMF signals.

A reference cannot anticipate a claim under § 102 if even one limitation is not found in the reference. MPEP § 2131. Aucsmith does not disclose a wireless transmitter for receiving electrical data and transmitting said electrical data in a wireless signal. Therefore, Aucsmith does not properly anticipate claim 43. No other rejection has been entered against claim 43. Accordingly, claim 43 should be allowed. Likewise, claims 44-45, which depend upon claims 43, should be allowable as well.

Claims 46-52

Claim 46 is an independent claim. It is reproduced below.

An apparatus for the telephonic distribution of electronic coupon data to a storage device, said apparatus comprising:

- a. an insertion port for receiving a coupon storage device;
- b. a modem for telephonically receiving electronic coupon data;
- c. a microprocessor controlling the receipt and transfer of electronic coupon data;
- d. a random access memory interacting with said microprocessor; and
- e. a telephonic subcomponent including a telephone keypad.

Claims 47 through 52 depend on claim 46.

Claim 53

Claim 53 is an independent claim. It is reproduced below.

A system combining an electronic coupon card with an adapter for transferring coupon data from another computer to said coupon card, said system comprising:

- a. an electronic coupon card having a microprocessor and circuitry for receiving and storing coupons;
- b. an adapter having:
 - i. an adapter body configured to receive and align receiving elements of said coupon card with transmitting elements of said adapter body;
 - ii. a reader operatively connected to said adapter body and allowing said adapter to receive coupon data from another computer; and
 - iii. a processor for receiving coupon data from said reader and transferring said coupon data to said coupon card for storage thereon.

The examiner has rejected claims 46 and 53 as being obvious under § 103 over U.S.

Patent 5,250,789 to Johnson ("Johnson") in view of 5,663,553 to Aucsmith ("Aucsmith"). To establish a *prima facie* case of obviousness based upon the combination of two or more references, the examiner must establish first that there is a motivation to combine the references

and second that the combined references teach or suggest all of the limitations of the claims. MPEP §§ 2143.01-2143.03. The teaching or suggestion to make the combination must be found in the prior art and not the applicant's disclosure. MPEP § 2142. Additionally, if the proposed modification would render the prior art device being modified unsatisfactory for its intended purpose, there is no suggestion to make the proposed modification. MPEP § 2143.01

The examiner has not shown a basis for combining Aucsmith and Johnson. In an effort to establish a basis for combining Aucsmith and Johnson the examiner has stated only:

In view of the disclosure of Aucsmith above, it would have been obvious to employ the device of Aucsmith into the system of Johnson so that shoppers can securely personalizing (sic) their shopping list into smart cards before going to market. Such modification would (sic) convenient and reliable.

April 17, 2001, Office Action, p. 3.

Johnson is configured to read data on a floppy disk. Johnson, Col. 5, ll. 60-64. There is no mention in Johnson anywhere of smart cards or smart card compatibility. If a shopper "personalized his shopping list onto a smart card" as the examiner suggests, the device of Johnson would not be able to read it when the shopper arrived at the store. Moreover, the examiner has provided no citation to anything *in the prior art* which would suggest why a shopper using the Johnson device would want to "personalize their shopping list onto a smart card" or what benefit would be derived from doing so. In the absence of such a showing the examiner has provided no basis for combining the references and has, therefore, not met his *prima facie* burden with respect to these claims.

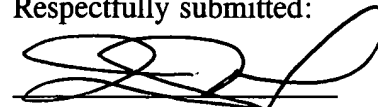
Even if the combination of Aucsmith and Johnson were suggested in the prior art, the combination would not teach or suggest every limitation in claim 46. Claim 46 requires the claimed apparatus to contain a "a modem for telephonically receiving electronic coupon data."

This is a functional limitation specifically requiring that the modem be configured to receive electronic coupon data. Johnson discloses a modem; however, the only function disclosed for the modem in Johnson is to receive shopping lists from customers. Johnson, Col. 7, ll. 22-29. Nowhere in Johnson is there any disclosure regarding the use of a modem to send or receive coupon data. Aucsmith does not disclose coupon data or a modem. Thus, when the two references are combined, they do not teach or suggest the functional limitation that the modem be configured to receive coupon data. Therefore, the references do not teach or suggest all of the limitations of claim 46, even if they are combined, and the examiner has not met his *prima facie* case with respect to claim 46 and the claims that depend therefrom.

Claim 53 requires "an electronic coupon card having a microprocessor and circuitry for receiving and storing coupons." Aucsmith discloses an electronic card having a microprocessor and circuitry; however, nothing in Aucsmith or Johnson suggests modifying either the microprocessor or the circuitry to receive or store coupons. More importantly, the examiner has not explained what in the prior art suggests such a modification. Therefore, the examiner has not met his *prima facie* case with respect to claim 53.

In view of the foregoing, all of the claims remaining in the application are believed to be patentable over the art of record and an early notice of allowability is respectfully requested.

Respectfully submitted:



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